REMARKS

Favorable reconsideration of the application is respectfully requested in light of the amendments and remarks herein.

Upon entry of this amendment, claims 13, 14, 16-18, and 20 will be pending. By this amendment, claims 15 and 19 have been canceled; claims 13 and 17 have been amended; and claims 21-23 have been added. No new matter has been added.

§103 Rejection of Claims 13-20

In Section 5 of the Office Action, the Examiner has rejected claims 13-20 under 35 U.S.C. §103(a) as being unpatentable over Cluts (U.S. Patent No. 5,616,876) in view of Atcheson *et al.* (U.S. Patent No. 5,583,763; hereinafter referred to as "Atcheson") and further in view of Schiller *et al.* (U.S. Patent No. 5,499,046; hereinafter referred to as "Schiller"). Claims 13 and 17 have been amended to address the rejection.

In the Background section of the Specification, it was disclosed that "[t]he average user, however, typically has no access to this tailor-made expert information. Namely, the user may own a number of Compact Disks (CD) with classical music, for example, and he or she listens to these CDs in random order. Although the pieces in the user personal library can be researched individually to determine what every one of them represents, the user typically cannot properly digest and synthesize such a piece-meal information to obtain a collection that transcend the user's random listening. Only with the music experts' help can the user achieve that ultimate listening experience by combining individual pieces from various CDs to form a special playlist: it is as if a unique CD or tape were produced for the user by an expert or group of experts. It is possible to obtain such a unique CD by spending a lot of effort in laboriously writing down the

titles of each album and sending them to the experts. Or, the experts may be invited to the user's home for advice and coffee. Both alternative do not appear to be viable or, at least, easily achievable." *Background of the Specification, page 1, line17 to page 2, line 10 (emphasis added).*

To address the above-described difficulties, embodiments of the present invention provide system and method for accessing, over a wide area network, multimedia equipment for reproducing multimedia information recorded on data storage media. For example, the structure of system claim 13, as presented herein, includes:

> "*generating means* for generating a list of contents of multimedia information recorded on data storage media of a first user at a first equipment location by processing contents data of each medium in the data storage media at the first equipment location, said generating means operating to transfer said list of contents via said wide area network to a second user at a second equipment location, said second user modifying the generated list of contents by selecting items from said list of contents and rearranging the selected items to produce a rearranged list of contents;
>
> *converting means* for converting the rearranged list of contents to at least one command for controlling the multimedia equipment; and
>
> *controlling means* for controlling the multimedia equipment based on said one command, wherein the multimedia information recorded on the first user's storage media is reproduced on the multimedia equipment, located at the first equipment location, based on the rearranged list of contents."
>
> (emphasis added)

In summary, the generating means of the system in claim 13 generates a list of contents of multimedia information by processing contents data of each medium in the data storage media at the first equipment location (*e.g.*, in CDs of a CD changer in the user's home) to address the difficulty of having to spend a lot of effort in laboriously writing down the titles of each album (*e.g.*, in CDs of a CD changer in the user's home) and sending them to the experts or inviting the experts to the user's home for advice. Further, the controlling means controls the multimedia

equipment so that multimedia information recorded on the first user's storage media is reproduced on the multimedia equipment, located at the first equipment location of the first user (*i.e.*, the student), based on the rearranged list of contents.

It was indicated in Section 6 of the Office Action that Cluts discloses the generating means in that "Cluts teaches a playlist that is generated for the subscriber by the service provider or publisher", referring to Fig. 4 and col. 12, lines 40-64. This position is respectfully traversed.

The system in Cluts is an audio on demand system that has nothing to do with a user's existing data storage media. In the Cluts system, an interactive network *provides music to subscribers*. (See abstract.) That is, unlike the limitations of claim 13, the subscribers are not already in possession of the recorded multimedia information to be subsequently reproduced in accordance with a rearranged list. Referring specifically to Fig. 4 and col. 12 of Cluts, what is disclosed is a screen display in the audio on demand system. Buttons on the screen enable the subscriber to select individual songs, to select a playlist, or to build his own playlist. However, these songs are not already recorded on data storage media of the user; rather, they are stored at the service provider facilities. See, *e.g.*, FIG. 1, and col. 7, lines 2-7, which reveal that the music is stored on memory storage device 30 located at the headend system, not at the consumer system 14.

Accordingly, Cluts fails to teach or suggest a system including a generating means, which generates a list of contents of multimedia information by processing contents data of each medium in the data storage media at the first equipment location and which transfers the list of contents to a second user to produce a rearranged list of contents, and a controlling means for controlling the multimedia equipment so that multimedia information recorded on the first user's

storage media is reproduced on the multimedia equipment, located at the first equipment location of the first user, based on the rearranged list of contents.

Atcheson relates to a system for downloading music to subscribers based on their selections from a menu, not to a system for controlling reproduction of multimedia information already recorded on a user's storage media. See *e.g.*, col. 3, lines 51-63 of Atcheson.

It was indicated that "Schiller discloses a second user modifying the generated list." Applicants respectfully disagree. There is no second user in Schiller that modifies a generated list of a first user by rearranging its contents. Schiller relates to a cable television system including a plurality of headends. Each headend outputs different video/audio programs to subscribers via a plurality of channels. Each channel is assigned to a particular company (such as HBO). The playlist for each channel is generated and modified by a separate scheduling computer at a location remote from the headend. Thus, a company can control the programs, scheduling, *etc.* of its assigned channel from a remote location.

Further, even if it is assumed that Schiller discloses a second user modifying the generated list, Cluts, Atcheson, and Schiller, in combination or individually, fail to teach or suggest a system including a generating means, which generates a list of contents of multimedia information by processing contents data of each medium in the data storage media at the first equipment location and which transfers the list of contents to a second user to produce a rearranged list of contents, and a controlling means for controlling the multimedia equipment so that multimedia information recorded on the first user's storage media is reproduced on the multimedia equipment, located at the first equipment location of the first user, based on the rearranged list of contents.

Based on the foregoing discussion, it is maintained claim 13 should be allowable over the

combination of Cluts, Atcheson, and Schiller. Furthermore, since independent claim 17 closely parallels, and includes substantially similar limitations as, independent claim 13, claim 17 should also be allowable over the combination of Cluts, Atcheson, and Schiller. Since claims 14, 16, 18, and 20 depend from claims 13 and 17, claims 13 and 17 should also be allowable over the combination of Cluts, Atcheson, and Schiller. Claims 15 and 19 have been canceled.

Accordingly, it is submitted that the Examiner's rejection of claims 13-20 based upon 35 U.S.C. §103(a) has been overcome by the present remarks and withdrawal thereof is respectfully requested.

§103 Rejection of Claims 13-20

In Section 15 of the Office Action, the Examiner has rejected claims 13-20 under 35 U.S.C. §103(a) as being unpatentable over Cluts in view of Atcheson and further in view of Foladare *et al.* (U.S. Patent No. 5,583,763; hereinafter referred to as "Foladare"). Claims 13 and 17 have been amended to address the rejection.

Foladare relates to a radio subscription system that enables a subscriber to remotely define and identify one or more playlists, each specifying information content *selected by the subscriber* from a subscription content database. (See abstract; and col. 2, lines 2-5.) Thus, Foladare fails to teach or suggest a system including a generating means, which generates a list of contents of multimedia information by processing contents data of each medium in the data storage media at the first equipment location and which transfers the list of contents to a second user to produce a rearranged list of contents, and a controlling means for controlling the multimedia equipment so that multimedia information recorded on the first user's storage media

is reproduced on the multimedia equipment, located at the first equipment location of the first user, based on the rearranged list of contents.

Based on the foregoing discussion, it is maintained that Cluts, Atcheson, and Foladare, in combination or individually, fail to teach or suggest all the limitations of claim 13. Therefore, claim 13 should be allowable over the combination of Cluts, Atcheson, and Foladare. Furthermore, since independent claim 17 closely parallels, and includes substantially similar limitations as, independent claim 13, claim 17 should also be allowable over the combination of Cluts, Atcheson, and Foladare. Since claims 14, 16, 18, and 20 depend from claims 13 and 17, claims 13 and 17 should also be allowable over the combination of Cluts, Atcheson, and Foladare. Claims 15 and 19 have been canceled.

Accordingly, it is submitted that the Examiner's rejection of claims 13-20 based upon 35 U.S.C. §103(a) has been overcome by the present remarks and withdrawal thereof is respectfully requested.

§103 Rejection of Claims 13-20

In Section 25 of the Office Action, the Examiner has rejected claims 13-20 under 35 U.S.C. §103(a) as being unpatentable over Cluts in view of Atcheson and further in view of Duso *et al.* (U.S. Patent No. 5,892,915; hereinafter referred to as "Duso"). Claims 13 and 17 have been amended to address the rejection.

With the Duso system, the user, *i.e.*, the client, is in control of the generation and the subsequent editing of his own playlist, of which both tasks are performed through a server. The server is not a second user. There is no second user involved in rearranging a first user's playlist. Col. 44, lines 13-24 and col. 45, lines 10-13 reveal:

> "The client first creates a session with a play-list containing a fixed number of entries ... The client application does this by first sending a "create session" command to the video file server ... *The server initially creates the play-list as empty*, and it must be populated with at least one clip before playing of a broadcast session may be started ... The server returns a 'session handle' to the client, to identify the broadcast video session ... the client receives the session handle, and uses it to send one or more 'edit session' commands to the video file server to add one or more clips to the play-list."

From the above passages it is readily apparent that the client creates his or her own playlist and then is allowed to edit the same remotely. As the initial play-list is empty, the client cannot be rearranging a list of contents of another client. Thus, Duso fails to teach or suggest a system including a generating means, which generates a list of contents of multimedia information by processing contents data of each medium in the data storage media at the first equipment location and which transfers the list of contents to a second user to produce a rearranged list of contents, and a controlling means for controlling the multimedia equipment so that multimedia information recorded on the first user's storage media is reproduced on the multimedia equipment, located at the first equipment location of the first user, based on the rearranged list of contents.

Based on the foregoing discussion, it is maintained that Cluts, Atcheson, and Duso, in combination or individually, fail to teach or suggest all the limitations of claim 13. Therefore, claim 13 should be allowable over the combination of Cluts, Atcheson, and Duso. Furthermore, since independent claim 17 closely parallels, and includes substantially similar limitations as, independent claim 13, claim 17 should also be allowable over the combination of Cluts, Atcheson, and Duso. Since claims 14, 16, 18, and 20 depend from claims 13 and 17, claims 13

and 17 should also be allowable over the combination of Cluts, Atcheson, and Duso. Claims 15 and 19 have been canceled.

Accordingly, it is submitted that the Examiner's rejection of claims 13-20 based upon 35 U.S.C. §103(a) has been overcome by the present remarks and withdrawal thereof is respectfully requested.

Double Patenting Rejections

In Section 36 of the Office Action, the Examiner has rejected claims 13-20 under the judicially created doctrine of double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,356,933.

As noted by the Examiner, a timely filed Terminal Disclaimer may be used to overcome the double patenting rejections provided the conflicting patent is shown to be commonly owned with the present application.

U.S. Patent No. 6,356,933 is commonly owned with the present application and Applicants file herewith a Terminal Disclaimer. Accordingly, Applicants request that the double patenting rejections be withdrawn.

Newly-added Claims 21-23

Based on the foregoing discussion regarding claim 13, and since newly-added claims 21-23 depend from claim 13, claims 21-23 should be allowable the cited prior art references.

Conclusion

In view of the foregoing, entry of this amendment, and the allowance of this application with claims 13-23 are respectfully solicited.

In regard to the claims amended herein and throughout the prosecution of this application, it is submitted that these claims, as originally presented, are patentably distinct over the prior art of record, and that these claims were in full compliance with the requirements of 35 U.S.C. §112. Changes that have been made to these claims were not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112. Rather, these changes were made simply for clarification and to round out the scope of protection to which Applicant is entitled.

In the event that additional cooperation in this case may be helpful to complete its prosecution, the Examiner is cordially invited to contact Applicant's representative at the telephone number written below.

The Commissioner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account 50-0320.

Respectfully submitted,

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